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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,133	01/19/2001	Jonathan E. Lowthert	42390P10893	9485

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TROP PRUNER & HU, PC  
8554 KATY FREEWAY  
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HOUSTON, TX 77024

EXAMINER
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RAMAN, USHA

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/766,133	<b>Applicant(s)</b> LOWTHERT ET AL.	
	<b>Examiner</b> Usha Raman	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 27-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20050909</u> . | 6) <input type="checkbox"/> Other: _____  |

### ***Response to Arguments***

1. Applicant's arguments filed September 7<sup>th</sup>, 2005 have been fully considered but they are not persuasive.

Applicant argues that Zigmond only shows that, "programming is provided as a video program feed (not from a stored source)" and that "no figure shows a storage that could store the content". The examiner respectfully disagrees with applicant's assertions. Zigmond discloses that content source maybe any storage medium carrying recorded video programming (see column 7, lines 9-12). Therefore Zigmond discloses that programming maybe be provided from a stored source.

Applicant also argues that Zigmond merely indicates that, "repository must have a medium that is capable of storing encoded video programming, not one that stores a streaming content". However, none of the claims recite such limitations.

Applicant continues to traverse Zigmond stating that, "the shell cannot find a place to insert ad in the cached content *before the cached content is streamed out*" and further argues that "insertion decision is made in real time as content is streaming through his system, and therefore does not make the decision while the content is still stored in the cache". The examiner respectfully disagrees. The claims recites, "an interface to utilize the information segment to identify the location while the content is still stored in the cache". Zigmond meets this limitation when using EPG triggers to insert ads in the programming, by using the info segment to identify the location, *while content is stored in cache*. Examiner would

like to emphasize the fact that when a videotape, or storage medium is used as the content source, the content is still in the storage medium during playback.

Therefore the advertisement insertion is done during playback, while the content is still present in storage medium.

As a result, examiner maintains rejection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond (US Pat. 6,698,020).

A receiver (80) to receive content with an information segment (ad selection criteria, see column 11, lines 50-53, lines 66-67, and column 12 lines 1-9) and a plurality of advertisements (see fig. 5);

A cache coupled to the receiver to store content with the information segment (see column 11, lines 30-35) and advertisement (86, column 4, lines 21-23, column 15, lines 24-25); and

An interface in said receiver (see column 6, lines 3-5, lines 51-53) to utilize the information segment to identify a content location and an advertisement (see column 12, lines 33-43, and lines 47-51), out of plurality of advertisements, to

insert in the location (see column 11, lines 31-35, column 12, lines 47-51), the interface to utilize the information segment to identify the location while the content is still stored in storage medium (i.e. when programming source is storage medium, the content is still stored in storage medium).

Zigmond does not disclose that the storage medium (e.g. video tape) providing the content comprises a cache.

Examiner takes official notice that cache was well known at the time of the invention, as used to store data requiring fast retrieval access.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system to include a cache as the storage medium for providing programming content, thereby enabling fast retrieval of content.

In regards to claim 28, the modified system comprises a shell utilizing an info segment with an interruption point specifier to indicate a point to insert the advertisement in the content (see column 17, lines 24-31).

In regards to claim 29, the modified system comprises a shell utilizing an info segment having a plurality of fields, one field comprising an interruption point specifier to indicate a point to insert the advertisement in the content, another field indicating, permitted ad type specifier, a prohibited ad type specifier (via content ratings, see column 13, lines 48-51).

In regards to claim 30, the modified system comprises a shell utilizing an info segment having an ad entry, wherein the ad entry has plurality of fields (column 11, lines 35-42).

In regards to claim 31, the modified system comprises the cache storing an electronic programming guide having a program identifier (see column 10, lines 64-67, column 11 lines 1-2) and an associated info segment (see column 11, lines 43-47), the electronic programming guide enabling locating the info segment corresponding to a selected program (column 11, lines 43-47, column 12, lines 60-62, lines 47-51).

In regards to claim 32, the modified system comprises a television receiver (see column 6, lines 34-44).

In regards to claim 33, the modified system lacks a presentation device connected to the system via a wireless connection.

Examiner takes official notice that it was well known at the time of the invention to use a presentation device coupled to a system over a wireless link.

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the system to include a presentation device for presenting data over a wireless link. The motivation is to be able to present data to a user over wireless presentation devices.

In regards to claim 34, the system discloses that location for insertion are identified by triggers, however does not indicate that the location is where the sound volume goes to zero.

Examiner takes official notice that audio and video breaks (i.e. low volume, blank video frames) indicating beginning and end of advertisement slot in programming broadcasts were well known in the art at the time of the invention. It

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would be further obvious to include zero audio to indicate the breaks, so that the trigger for a commercial slot is detectable by the receiver system.

It would have been obvious to one of ordinary skill in the art at the time of the invention to detect zero volume "breaks" in a telecast and identify it as the location for advertisement placement. The motivation is to place advertisement in locations that broadcaster has indicated for advertisements to be placed at.

### ***Conclusion***


4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Johnston et al. (US Pat. 4,390,904) discusses the well-known use of audio and video breaks in telecast for detection of advertisements. See Johnston: column 2, lines 53-column 3, line 4. Freeman et al. (US Pre Grant Pub. 2001/0013123) discloses a system using a wireless presentation device such as wireless telephones, PDA, etc. (see Freeman: page 10, [0076])
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (571) 272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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